application. For the convenience of the Examiner, a copy of the Claims as pending after entry of this Amendment, is attached hereto as Exhibit A.

ELECTION OF SPECIES

Regarding the Election of Species, Applicants affirm their election of Species 1, drawn to nucleic acid capture only, without traverse. Claims 1-36, 40, 41, 44, 50-56 and new Claims 57-67 read on the elected species. Applicants understand their election is being made solely to facilitate examination of the application and that they are entitled to consideration of additional species upon allowance of a generic claim.

Applicants would also like to correct a minor error noted in the record. In discussing the election of species, the Examiner states that Ms. Jennifer Weltlich provisionally elected Species 1. However, it was Ann M. Caviani Pease (Reg. No. 42,067), an associate of Mr. Samuel B. Abrams (the attorney of record), with whom the Examiner spoke and who made the provisional election of Species 1.

THE AMENDMENTS OF THE SPECIFICATION

The specification has been amended to update the cross-reference and to correct minor typographical errors noted by the Examiner. Also, the Brief Description of the Drawings has been amended to conform the figure references to the formal drawings which are being submitted concurrently herewith.

Regarding the cross-reference, Applicants note that the parent application originally received Serial No. 09/200,264 but was converted to a provisional application bearing application No. 60/135,516 on February 22, 1999.

No new matter is introduced by the above-discussed amendments. Accordingly, entry into the instant application is kindly requested.

THE AMENDMENTS OF THE CLAIMS

Claims 1-11, 13, 14, 21-36, 38, 40, 44, 50 and 52 have been amended, Claims 12, 16-20, 37-39, 42, 43, 45-49 and 53-56 have been canceled without prejudice and Claims 57-67 have been newly added. As will be discussed more thoroughly in a later section, the

amendments and new claims are believed to be in condition for allowance. The various amendments are discussed in detail, below.

Claim 1 has been amended to include the thickness limitation of allowable Claim 2. Allowable Claims 6, 9, 11 and 13 have been redrafted as new independent Claims 57, 58, 59 and 60, respectively. Dependent Claims 2-21 have been amended to multiply depend from amended Claim 1 and/or new Claims 57-60.

Independent Claim 13 has been amended to depend from amended Claim 1 and to delete the expression "(i)", as suggested by the Examiner. In addition, method Claims 61, 62, 63 and 64 have been newly added. New method Claims 61, 62, 63 and 64 are similar to Claim 23, but depend from new Claims 57, 58, 59 and 60, respectively. Claims 24-36, which originally depended from Claim 23 have been amended to include multiple dependencies to new Claims 61, 62, 63 and/or 64, and to correct errors in antecedent basis introduced from the new multiple dependencies.

Method Claim 40 and kit Claim 44 have been amended to multiply depend from amended Claim 1 and new Claims 57-60. In addition, in Claim 40, the designations "(c)" and "(d)" have been deleted in favor of "(a)" and "(b)", respectively.

Kit Claims 50 and 52 have been amended to include a three-dimensional porous substrate having the pore size and porosity features of allowable Claim 13. The active group densities deleted from amended Claims 50 and 52 are recited in new Claim 65. New dependent Claims 66 and 67 recite specific materials comprising the porous substrate.

The amendments of Claims 1-11, 13, 14, 21-36, 40, 44, 50 and 52 and new Claims 57-67 are fully supported by the specification and claims as originally filed and do not introduce new matter. Accordingly, entry into the instant application is proper and respectfully requested.

CLAIM OBJECTIONS

Applicants have amended Claim 22 to insert a comma between "a spin column" and "a micro-channel" as suggested by the Examiner. Claims 54 and 56 have been canceled, rendering the objection moot.

REJECTION UNDER 35 U.S.C.§112, SECOND PARAGRAPH

Claims 23 and 36 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for reciting the expression "(i)". This expression has been deleted from Claims 23-36, rendering the rejection moot. Accordingly, Applicants request that the rejection of Claims 23-36 under 35 U.S.C. § 112, second paragraph, be withdrawn.

REJECTION UNDER 35 U.S.C §102

Claims 1, 3, 12, 15, 23, 26, 27, 32, 36, 40, 41, 44, 53 and 54 stand rejected under 35 U.S.C. § 102(e) as being allegedly anticipated by EP 0 605 828 A1 to Feindt *et al.* ("Feindt *et al.*").[1/] Claims 1, 3, 5, 7, 8, 12, 14, 15, 21-23, 27, 29, 31, 32, 40, 41, 44, 53 and 54 stand rejected under 35 U.S.C.§ 102(e) as being allegedly anticipated by U.S. Patent No. 5,741,647 to Tam *et al.* ("Tam *et al.*"). Applicants traverse the rejections.

In order to anticipate, a cited reference must teach each and every element of a rejected claim. Neither Feindt *et al.* nor Tam *et al.* teach each and every element of Claim 1. Specifically both Feindt *et al.* and Tam *et al.* teach the use of Biodyne C membranes in certain assays. Claim 1 recites a flow-through capture device comprising a *three-dimensional porous substrate* having certain features. The differences between the three-dimensional porous substrates recited in Claim 1 and membranes such as those used in the cited references are taught in the specification at page 10, lines 16-26. Neither Feindt *et al.* nor Tam *et al.* teach or suggest three-dimensional substrates, as recited in Claim 1. Accordingly, neither of these references anticipates Claim 1 or any of the claims that depend therefrom.

Nonetheless, in order to highlight the three-dimensional nature of the porous substrate of the flow-through device of Claim 1, Applicants have amended Claim 1 to include therein the thickness limitation (about 1 mm to 20 mm) of allowable Claim 2. All of the remaining claims under consideration have been amended to ultimately depend from amended Claim 1, or from new independent Claims 57-60, which correspond to allowable Claims 6, 9, 11, and 13, respectively. Claim 12 has been canceled. As a consequence, Claims 1-11, 13-15, 20-36, 40, 41, 44, 50-52 and 57-67 all recite allowable subject matter. Accordingly, Applicants

[1/] Applicants believe the Examiner intended to reject the claims under a different subsection of § 102, as §102(e) relates to issued U.S. patents.

respectfully request that the rejection of Claims 1, 3, 5, 7, 8, 12, 14, 15, 21-23, 26, 27, 29, 31, 32, 36, 40, 41, 44, 53 and 54 under 35 U.S.C. § 102 be withdrawn.

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REJECTION UNDER 35 U.S.C. §103(a)

Claims 1, 3-5, 8, 12, 14-18, 20-25, 27-29, 32, 36, 40, 41, 44 and 50-56 stand rejected under 35 U.S.C.§103(a) as being unpatentable over EP 0 455 905 A2 to Van Ness *et al.* ("Van Ness *et al.*") in view of Fahy *et al.*, 1993, Nucl. Acids Res. 21:1819-1826 ("Fahy *et al.*") and further in view of BioRad catalog page 71 ("BioRad"). Applicants submit the rejection is moot for the reasons cited above. Claim 1 has been amended to include the thickness limitation of allowable Claim 2. Allowable Claims 6, 9, 11 and 13 have been redrafted as independent Claims 57, 58, 59 and 60, respectively. Claims 12, 16-20 and 53-56 have been canceled. All other claims under consideration have been amended to ultimately depend from a claim reciting subject matter the Examiner has indicated is allowable. Accordingly, Applicants respectfully request that the rejection of Claims 1, 3-5, 8, 12, 14-18, 20-25, 27-29, 32, 36, 40, 41, 44 and 50-56 under 35 U.S.C. §103(a) be withdrawn.

CONCLUSION

Applicants respectfully submit Claims 1-11, 14, 15, 19-36, 40, 41, 44, 50-52 and 57-67, as amended, satisfy all of the criteria for patentability and are in condition for allowance. An early indication of the same and passage of the claims to issuance is therefore kindly solicited.

No fees are believed due in connection with this Amendment beyond those indicated on the enclosed fee sheet. However, any required fees may be charged, or any over payments credited, to Pennie & Edmonds LLP Deposit Account No. 16-1150.

Respectfully submitted,

By: [signature] 42067

Date March 16, 2000

[signature] 30,605

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Enclosures